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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,083	11/06/2003	Heinz Focke	Q78287	8033

23373 7590 03/22/2007  
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WASHINGTON, DC 20037

EXAMINER
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MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
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1733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/702,083	<b>Applicant(s)</b> FOCKE ET AL.	
	<b>Examiner</b> Barbara J. Musser	<b>Art Unit</b> 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 22, it is unclear what is meant by "the positioning of the folding coupon on the folding legs" in lines 7-8, since the coupon is not located on the folding legs. For the purposes of examination this is considered to mean --the position of the folding legs of the folding coupon--.

Regarding claim 24, it is unclear which folding step is referred to as claim 16 and claim 22 have folding steps, which the specification indicates are separate folding processes since they are separated by a cutting step. For the purposes of examination, this is considered to refer to the folding step of claim 16.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk (U.S. Patent 4,812,195) in view of Brown and Vijuk (U.S. Patent 4,817,931).

Vijuk '195 discloses a method of forming printed folded carriers(outserts) wherein a web which can be double width is cut into sheets(31), folded(33), adhesive is applied(45), and the web is cut longitudinally to form two carriers(53) adjacent each other.(Col. 3, ll. 49-57; Figure 1) The reference does not disclose the type of adhesive applied, applying the adhesive before cutting the web into sheets, or activating the adhesive by heat after folding. Brown discloses a method of making printed material wherein hot-melt adhesive is applied to regions of a continuous web, blanks are cut from the web which are then folded, and then applying heat and pressure to activate the adhesive.(Col. 3, ll. 17-68) Vijuk '931 discloses a method of making printed folded carriers wherein a sheet of printed material is folded, and a hot-melt adhesive is applied.(Col. 3, ll. 30-36; Col. 4, ll. 3-5; Col. 7, ll. 1) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply hot melt adhesive to regions of the web of Vijuk '195 prior to cutting it and then activate them after folding the web since Brown shows this is an obvious alternative to applying the adhesive after cutting and folding as taught by Brown(Col. 3, ll. 17-68) and since Vijuk '931 shows it is known to use hot melt adhesive with outserts like those of Vijuk '195 and since this would increase the accuracy of the adhesive placement since it would be applied to a continuous web rather than individual articles.

Regarding claim 16, while the reference do not disclose using a double width and double layered web, Vijuk '195 discloses a double width web.(Col. 3, ll. 54-57) Vijuk '931 discloses an individual carrier can be folded lengthwise, making a double layered web, prior to being folded widthwise. It would have been obvious to one of ordinary skill

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in the art at the time the invention was made to fold the double width carrier longitudinally so that the edges meet in the center to make a double layered web since Vijuk '931 discloses the carriers can be folded in two directions to make a double layered web and since this would allow formation of two adjacent double layered carriers and to perform this folding while the web is continuous since longitudinally folding a continuous web is simple.

Regarding claim 17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a small space between the folded longitudinal sides of claim 16 so that the edges would not be cut off accidentally.

Regarding claim 18, while the references only show one adhesive location per carrier, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply adhesive at a second location on the opposite side of the carrier to bond some of the interior folds together so that the carrier does not inadvertently open.

Regarding claim 19, Vijuk '195 discloses using marks to determine the cutting locations. (Col. 4, ll. 26-30) Since the glue is to be applied relative to the cutting locations, one in the art would appreciate that the same marks used to determine the cutting location could also be used to determine the adhesive application location, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cutting marks to apply the adhesive prior to cutting since this would insure the adhesive is applied to the correct locations on the web.

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Regarding claim 20, while the references do not disclose where the heating to activate the adhesive occurs, since the adhesive is intended to bond the layers of the carrier together during the pressing and transporting, one in the art would appreciate that the heat used to activate the adhesive would be applied during the pressing and transporting steps. Since the transporting steps use belt conveyors(56,57), one in the art would appreciate that the heating would occur while the carriers are being transported by the belt conveyors as this would be an obvious location to which to apply heat to bond the carrier to itself.

Regarding claim 21, while Vijuk '195 does not disclose score lines, Vijuk '931 discloses forming score lines in the carrier at location corresponding to the fold lines.(Col. 4, ll. 50-56) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply score lines to the web and to do this before cutting it into individual sheets since such score lines are known in the outsert art as shown by example by Vijuk '931 and since such score lines would make folding easier as is well-known in general and to perform this scoring before cutting since this would be simpler than scoring individual sheets. While Vijuk '931 does not describe the rollers as a stamping element, applicant's specification shows that rollers which cooperate to form an indentation are a stamping element(Figure 5), and Vijuk '931 discloses rollers which cooperate to form an indentation.(Figure 5, Col. 4, ll. 50-56)

Regarding claims 23 and 24, since the combination of Vijuk '195, Brown, and Vijuk '931 folds the outserts after application of the adhesive, one in the art would appreciate that the folding step that occurs after cutting would occur in a single process

since it only occurs in two steps in Vijuk '195 because the application of adhesive needs to occur before the final folding step and after the article is mainly folded.

### ***Response to Arguments***

5. Applicant's arguments filed 2/22/07 have been fully considered but they are not persuasive.

Regarding applicant's argument that Vijuk '195 uses two folding steps, the majority of the claims are not restricted to only one step. Additionally, when the steps of applying the adhesive, hardening it, cutting, folding, and activating the adhesive is used from Brown, only one folding step is required.

6. In response to applicant's argument that Brown is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is in the same general field of endeavor since it deals with the folding of individual articles from a continuous web of paper, and it is reasonably pertinent to applicant's problem since it deals with a method of applying adhesive which can be applied when the paper is continuous but not activated until later.

Regarding applicant's argument that Brown is permanently adhesive, the reference clearly indicates the adhesive is a heat-activated adhesive(Col. 3, ll. 37-39)

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indicating it is clearly not permanently adhesive is it is only adhesive when activated by heat, since that is the definition of a heat-activated adhesive.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
BJM

  
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